

### **REMARKS**

The following issues are outstanding in the pending application:

- Claims 1, 21 and 25 are rejected under 35 USC 112;
- Claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28 are rejected under 35 USC 103;
- Claims 10-12 are rejected under 35 USC 103;
- Claims 16 and 26 are rejected under 35 USC 103; and
- Claims 22-24 are rejected under 35 USC 103.

### **Claim Amendments**

The claims have been amended in order to more clearly define the subject matter of the invention. Claims 1, 21 and 25 have been amended to recite positive and negative moulds each having a lower edge portion and a central upper portion in which a single receptacle depression is formed in the film material between the moulds. The tension of the film material is controlled and reduced while it is being moulded in which additional film material is allowed to penetrate between the positive and negative moulds in order to form lateral creases in the film material around the entire lower edge portion of the mould while the film material in the central upper portion of the mould retains its original shape during the deforming procedure. Claims 7 and 23 have been amended to conform the subject matter to the amendment in claim 1 and 21 respectively. No new matter has been added.

### **35 USC 112**

Claims 1, 21 and 25 are rejected under 35 USC 112, second paragraph as being indefinite as it is unclear what parts of the mold elements contain the edges and upper portions. These claims have been amended to recite that each mould has a lower edge portion and a central upper portion. Support for this is found in paragraph [0035]. No new matter has been added. Thus, Applicant respectfully submits that this rejection has been overcome.

35 USC 103

**Claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28** are rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 4,246,223 to Patterson in view of U.S. 2002/0079611 to Ellison et al. Applicant respectfully traverses this rejection.

Patterson discloses a method and apparatus for making compartment trays formed from coated paper milk carton stock in which the compartments are separated by dividers. Tray blanks are cut and are scored in order to control the formation of wrinkles when the blank is folded and formed in the single set of dies. The forming and wrinkling of the tray surface is controlled by the positions of the scored regions of the blank. The mating male and female dies form three compartments in the tray blank.

Ellison discloses a process and apparatus for preparing a molded article in which film is placed over a mold cavity and extending over the mold rim cavity. The film is held in place over the mold cavity by a frame that engages the film adjacent to the mold cavity rim. Molten plastic is poured over the film, forming a molded article in the shape of the mold cavity in which the film is an outer layer of the molded article. The film tension is controlled in order to minimize film thinning and wrinkling in the molded part.

*Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the

prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claims 1, 21 and 25 which require "positive and negative moulds each having a lower edge portion and a central upper portion in which a single receptacle depression is formed in the film material between the moulds. The tension of the film material is controlled and reduced while it is being moulded in which additional film material is allowed to penetrate between the positive and negative moulds in order to form lateral creases in the film material around the entire lower edge portion of the mould while the film material in the central upper portion of the mould retains its original shape during the deforming procedure.

The Patterson reference discloses dies for forming multiple compartments in a paper tray having dividers between the compartments in which the paper blanks are scored to causes wrinkles to form in the scored regions of the finished tray before placing the tray blank between a single set of dies. The paper stock is scored in the bend regions adjacent the ridges and corners of the tray to relive stresses occurring during the forming operation by inducing the paper stock to fold and form into the dies. During formation, the wrinkles are formed only in the corners of the three compartments of the tray. The scored blanks 28 are gravity-fed in an aligned orientation down a chute to a location between a female, die 52 and an associated, movable male, die 54. As the male die approaches the female die in a forming stroke, the first and second draw pads capture the blank. At the same time, the plungers contact the blank surface. As the forming stroke continues, the plungers pre-form the blank in the compartment regions between divider ridges on the female die while tension is maintained on a perimetral flange portion of the blank by the draw pads. The plungers finally bottom out, capturing the blank between themselves and the compartment surfaces of the

female die. The remaining parts of the male die continue downward, finally forming the tray. The tension on the blank is controlled as it is moved down into the female die in order to form the various parts of the three compartment tray. No additional blank material is allowed to penetrate between the male and female dies.

The Ellison reference is directed to preparing a molded article in which film is placed over a mold cavity extending over the mold rim cavity and molten plastic is poured over the film for forming a molded article in the shape of the mold cavity in which the film is an outer layer of the molded article. The film is held in place over the mold cavity by clamping pressure and an electromagnet that enables one to reduce the clamping pressure during the forming step by controlling and varying the clamping force electrically as desired during the molding cycle. The film is allowed to move under the clamp into the cavity in a predetermined controlled manner so as to minimize film thinning and wrinkling in the molded part.

In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claims and their meaning as the cited references do not include all elements of independent claims 1 and 19. This is because none of these references teach (1) controlling and reducing the tension of the film material while it is being moulded wherein (2) additional film material is allowed to penetrate between the positive and negative moulds in order to form (3) lateral creases in the film material around the entire lower edge portion of the mould while the film material in the central upper portion of the mould retains its original shape. Applicant respectfully asserts that the controlling of the tension on the tray blank in Patterson does not allow additional film material to penetrate between the positive and negative moulds. Nor does the Patterson reference teach the formation of lateral creases in the film material around the entire lower edge portion of the mould. In the Patterson tray, the wrinkles are formed only in the corners of the three compartments as shown in Fig. 2. The Ellison reference does not teach the formation of creases of any kind, because in the Ellison reference, the controlling of the tension of the film is to minimize wrinkling in the molded part. Thus, the claims are erroneously rejected over the cited references and Applicant respectfully requests the rejection be removed. Applicant respectfully asserts that modifying the teaching of

Patterson with the teaching of Ellison will not provide the method of independent claims 1 and 21 and the devise of independent claim 25. Therefore, Applicant respectfully submits that independent amended claims 1, 21 and 25 are not obvious.

If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition non-obvious. Applicant respectfully submits that claims 3-9, 14, 15, 17-20, 27 and 28 depend at least in part from amended independent claims 1, 21 or 25 respectively. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28 under 35 U.S.C. 103(a) as having subject matter unpatentable over U.S. Pat. No. 4,246,223 to Patterson in view of U.S. 2002/0079611 to Ellison et al.

**Claims 10-12** have been rejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 3,762,125 to Prena. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over Patterson and Ellison obviates the present rejection. The Prena reference adds no new teaching to the Patterson and Ellison references that would result in the inventive method of amended independent claim 1. Claims 10-12 depend at least in part on amended independent claim 1. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from claim 1, claims 10-12 are nonobvioius over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Patent No. 3,762,125 to Prena.

**Claims 16 and 26** have been ejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 4,124,421 to Fujii. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the Patterson and Ellison references obviates the present rejection. The Fujii reference adds no new teaching to these references that would result in the inventive method of amended independent claim 1 or 25. Claims 16 and 26 depend at least in part on amended independent claims 1 and 25 respectively. If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from claims 1 and 25 respectively, claims 16 and 26 are nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 16 and 26 under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison et al. in view of U.S. Patent No. 4,124,421 to Fujii.

Claims 22-24 have been ejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 5,009,056 to Porteous. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over Patterson and Ellison obviates the present rejection. The Porteous reference adds no new teaching to the Patterson and Ellison references that would result in the inventive method of amended independent claim 21. Claims 22-24 depend at least in part on amended independent claim 21. If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from claim 21, claims 22-24 are nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 22-24 under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison in view of U.S. Patent No. 5,009,056 to Porteous.

### **CONCLUSION**

In view of the above, applicant believes the pending application is in condition for allowance.

Application No. 10/540,591  
Amendment dated April 3, 2008  
Reply to Office Action of February 1, 2008

Docket No.: HO-P03195US0

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03195US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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